REMARKS

Applicants hereby traverse the outstanding rejections and request reconsideration and withdrawal in view of the amendments and remarks contained herein. Claims 1, 6, 8-11, 15, 19-23, 35, 39 and 40 have been amended. Claims 1-24 and 35-40 are pending in this application.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-24 and 35-40 stand rejected under 35 U.S.C. § 112, first paragraph as not complying with the written description requirement. Specifically, the Examiner states that the disclosure does not provide a clear description of the steps and structure required to provide the parameters as recited.

In response, Applicants have amended claims 1, 15, and 35 to more specifically recite the invention as described. Applicants have removed the phrases "providing a parameter" and "means for providing...a parameter" from the claims, and replaced them with "choosing a value for a ...parameter" and "a...parameter having a value selected to". By removing any reference in the claims to "providing a parameter", Applicants believe that the claims, as amended, are completely supported by the specification. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, first paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As the limitations of claims 1-24 and 35-40 are found in the specification, Applicants respectfully request the rejection of claims 1-24 and 35-40 under 35 U.S.C. § 112, first paragraph be withdrawn.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-24 and 35-40 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Examiner states that the term parameter is used inconsistently to mean both a variable and the value for a variable.

In response, Applicants have amended claims 1, 6, 8-11, 15, 19-23, 35, 39 and 40 to more accurately and precisely define the invention. Specifically applicant has used the word value where appropriate to clarify the distinction between a variable, or parameter, and the value for a variable, or parameter. The claims have been amended only for the purpose of

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complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment, Applicants respectfully request the rejection of claims 1-24 and 35-40 under 35 U.S.C. §112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 101

Claims 1, 15, and 35 are rejected as being directed to non-statutory subject matter. Specifically, the Examiner states that since the claimed steps are abstract, they are non-statutory. In response, Applicants have amended independent claims 1, 15, and 35 to more clearly recite elements consistent with 35 U.S.C. § 101. Claims 1 and 35, as amended, now recite "defining" or "establishing" a characteristic of a media by choosing a value for a parameter, or, in claim 15, a system formed by parameters having values chosen to accomplish the specific results of defining data areas and determining appropriate defect management. As a result, Applicants believe the steps or system claimed in claims 1, 15, and 35 are not abstract and comprise statutory subject matter.

The Examiner has also opined that the use of the term "media" may not be statutory. The Examiner is reminded that § 101 applies to the subject matter claimed as the invention and not to potentially indefinite elements recited in the claims. If the Examiner's intent was to question whether the use of the term media in the claims renders the claims indefinite under § 112, second paragraph, he is invited to reject the claims on those grounds.

The claims have been amended only for the purpose of complying with the requirements of statutory subject matter under 35 U.S.C. § 101 and not for the purpose of narrowing their scope in the face of prior art. The dependent claims have also been amended to reflect these changes, where necessary.

Rejection under 35 U.S.C. § 102

Claims 1-6, 9-10, 12-19, 21-22, 24, and 35-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Atsatt et al., U.S. Patent No. 5,983,309, (hereinafter Atsatt).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing In re Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 1, as amended, claims defining a user data replacement area on a media by choosing a value for a replacement area parameter. The present Office Action states that the #Slip_R variable described by Atsatt teaches the above recitation from claim 1. Applicants respectfully disagree. Atsatt, at column 9, lines 13-15 states: "The number of slipped sectors per sparing regions is located in #Slip_R". As Applicants noted in Applicants' Amendments of January 4, 2002, and May 7, 2002, and the Appeal Brief filed August 6, 2002, from this statement, it is evident that Atsatt's #Slip_R is not a replacement area parameter having a chosen value that defines a user data replacement area on the media, as recited by the claim. Instead, #Slip_R defines the number of slipped sectors within a sparing region, which is not useable as a replacement area or sparing area.

Further, Claim 1 requires that the defined user data replacement area be dependent upon the chosen value for the replacement area parameter. #Slip_R of Atsatt is simply the number of slipped sectors in a sparring region. It is not chosen to define a user data replacement area, as required by claim 1, but is merely a cumulative count of a characteristic of the sparring region in Atsatt. Accordingly, Atsatt does not teach defining a user replacement area by choosing a value for a replacement area parameter as recited in claim 1.

Claims 2-6, 9-10, and 12-14 depend directly from base claim 1, and thus inherit all limitations of the base claim. Further, claims 2-6, 9-10, and 12-14 set forth features and limitations not recited by Atsatt.

Claims 36 and 37 depend directly from base claim 35, and thus inherit all limitations of the base claims. Further, claims 36 and 37 set forth features and limitations not recited by Atsatt.

For the reasons set forth above, Applicants respectfully assert claims 1-6, 9-10, 12-19, 21-22, 24, and 35-37 are patentable over the 35 U.S.C. § 102 rejection.
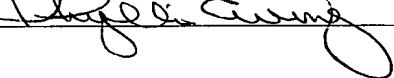
Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10980039-2 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail Label EV482746035US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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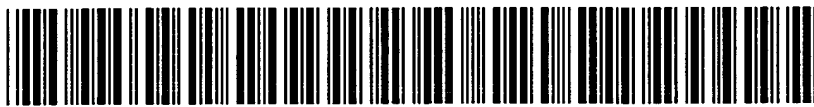Signature:

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